

## **REMARKS**

### **I.     Introduction**

Claims 1, 4-6, 8-10 and 12-17 are pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the present pending claims are allowable, and reconsideration is respectfully requested.

### **II.    Objection to Claims 14-16**

Claims 14, 15 and 16 have been objected to under 37 C.F.R. 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Claims 14-16 have been amended to recite that "the coating is also applied to inner walls of . . . ." Since amended claims 14-16 clearly recites that the contact of the coating with the inner walls of components is in addition to the contact of the coating with the outer surface of the element (as recited in claim 1), claims 14-16 further limit the subject matter of parent claim 1.

### **III.   Rejection of Claims 1, 4-6, 8-10 and 12-17** **under 35 U.S.C. § 103(a)**

Claims 1, 4-6, 8-10, 12, 13 and 17 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,465,618 to ("Yasui et al.") in view of U.S. Patent 4,345,465 to ("Gruner et al."). Applicants respectfully submit that the rejection should be withdrawn for the following reasons.

Claim 1 recites, in relevant parts, "an anti-adhesive surface coating acting . . . , wherein the coating contains at least one compound selected from the group consisting of fluoromocers, fluorine-containing silanes, polymeric fluorocarbon resins, and partially fluorinated polymers." The Examiner contends that since Gruner et al. reference teaches a protective layer of a polymer comprising hexafluoropropylene, "[o]ne of ordinary skill in

the art would be motivated to use the polymer comprising hexafluoropropylene as the protective layer of Yasui et al.” (Office Action, p. 4).

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Even if one assumes for the sake of argument that there would have been some motivation to combine the teachings of Yasui et al. and Gruner et al. references, it should be noted that Gruner et al. reference merely teaches the use of a polymer of hexafluoropropylene, i.e., a **fully fluorinated polymer**, as a protective layer. Accordingly, even if one combined the teachings of Yasui et al. and Gruner et al. references, only the use of a **fully fluorinated polymer** as a protective layer would have been suggested at best, but not the use of **partially fluorinated polymers** as recited in claim 1. For at least this reason, claim 1 and its dependent claims 4-6, 8-10, 12, 13 and 17 are not rendered obvious by the combination of Yasui et al. and Gruner et al. references.

Independent of the above, regarding claims 4, 5 and 10, the Examiner contends that “the stability temperature, surface energy, and

decomposition temperature are taken to be physical properties of the material,” and that “[s]ince Gruner et al. uses a fluorinated polymer for the protective coating as is done in the instant application, the protective coating of Gruner et al. is taken to inherently possess the same material properties as that of the instant invention.” (Office Action, p. 4). Furthermore, regarding claim 17, the Examiner contends that “the protective coating of Gruner et al. is taken to pass a cross-cut test since it is the same material as used in the instant invention and is designed to act as a protective layer.” As noted above, at best Gruner merely suggests the use of a **fully fluorinated polymer** as a protective layer, but not the use of **partially fluorinated polymers** as recited in claim 1. Accordingly, it cannot be concluded that “the protective coating of Gruner et al. is taken to inherently possess the same material properties as that of the instant invention.” For this additional reason, claims 4, 5, 10 and 17 are not rendered obvious by the combination of Yasui et al. and Gruner et al. references.

Claims 1, 4-6, 8-10 and 12-17 have also been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 4,606,952 to (“Sugimoto et al.”) in view of U.S. Patent 5,465,618 to (“Yasui et al.”) and U.S. Patent 4,345,465 to (“Gruner et al.”). Applicants respectfully submit that the rejection should be withdrawn for the following reasons.

While the Examiner concedes that Sugimoto et al. reference does not teach “the presence of a sensor element as recited in claim 1,” the Examiner contends that one of ordinary skill in the art would be motivated to:

- a) “use the sensor of Yasui et al. in the hose or pump of Sugimoto et al.”; and
- b) “use the polymer comprising hexafluoropropylene as the protective layer of Yasui et al.” (Office Action, p. 5).

As previously mentioned above, Gruner et al. reference merely teaches the use of a polymer of hexafluoropropylene, i.e., a **fully fluorinated polymer**, as a protective layer. Furthermore, the Examiner concedes that Sugimoto et al. reference does not teach “the presence of a

sensor element as recited in claim 1.” Accordingly, even if one combined the teachings of Sugimoto et al., Yasui et al. and Gruner et al. references, only the use of a **fully fluorinated polymer** as a protective layer would have been suggested at best, but not the use of **partially fluorinated polymers** as recited in claim 1. For at least this reason, claim 1 and its dependent claims 4-6, 8-10, 12, 13 and 17 are not rendered obvious by the combination of Sugimoto et al., Yasui et al. and Gruner et al. references.

Independent of the above, regarding claims 4, 5 and 10, the Examiner contends that “the stability temperature, surface energy, and decomposition temperature are taken to be physical properties of the material,” and that “[s]ince Gruner et al. uses a fluorinated polymer for the protective coating as is done in the instant application, the protective coating of Gruner et al. is taken to inherently possess the same material properties as that of the instant invention.” (Office Action, p. 5-6). Furthermore, regarding claim 17, the Examiner contends that “the protective coating of Gruner et al. is taken to pass a cross-cut test since it is the same material as used in the instant invention and is designed to act as a protective layer.” As noted above, at best Gruner merely suggests the use of a **fully fluorinated polymer** as a protective layer, but not the use of **partially fluorinated polymers** as recited in claim 1. Accordingly, it cannot be concluded that “the protective coating of Gruner et al. is taken to inherently possess the same material properties as that of the instant invention.” For this additional reason, claims 4, 5, 10 and 17 are not rendered obvious by the combination of Sugimoto et al., Yasui et al. and Gruner et al. references.

IV. Conclusion

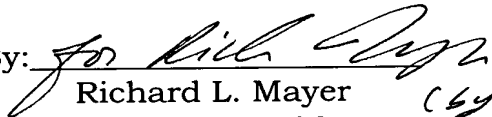
For the foregoing reasons, it is respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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